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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/698,644	10/27/2000	Gopalan Raman	10002988-1	6504

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EXAMINER

WILLIAMS, KEVIN D

ART UNIT PAPER NUMBER

2854

DATE MAILED: 08/14/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application N .

09/698,644

Applicant(s)

RAMAN, GOPALAN

Examiner

Kevin D. Williams

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 October 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) 6-9 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 10-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 October 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of the Group I invention, claims 1-5 and 10-17, in Paper No. 7 is acknowledged.

Claim Objections

2. Claims 4 and 14 are objected to because of the following informalities:

Claim 4 recites the limitation "the overlayer" in line 2. Claim 14 recites this limitation in line 3. It appears that there is insufficient antecedent basis for the limitation in the claims. Appropriate correction is required.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-3, 5, 10 and 12-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Daigneault (US 6,334,678) in view of Mehta (US 5,944,881).

With respect to claims 1, 2, 10, and 13-15, Daigneault teaches a method for printing a secure image on media using an inkjet printing device, the method comprising printing an underlayer 4 using an inkjet printing device where the underlayer defines an

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identification indicia. Daigneault teaches the underlayer being a watermark.

Watermarks are preprinted images that inherently receive a subsequent printed image that goes on top of the watermark when the media is printed by the end user.

Daigneault teaches that the underlayer can be printed from a group of various colors (col. 6, lines 51-53) that are independent of an ink color of the image to be printed by the end user. Daigneault teaches a storage device 28 for storing information specifying the underlayer, a control device 14 for selecting image information from the storage device to print the underlayer, an input device, and an underlayer wherein examination of a front surface allows viewing of the identification indicia for authenticating the secure image.

Daigneault does not teach the underlayer penetrating into a front surface of the media, the secure image completely covering the underlayer, the inkjet printing device for printing the underlayer being the same inkjet printing device for printing the overlayer, the underlayer being printed using one of magenta and cyan ink, the information from the input device being used for printing the overlayer, the underlayer being formed from a series of small ink drops that are sufficiently small to prevent viewing with the naked eye and under normal light, and examination of a back surface opposite the front surface allowing viewing of the identification indicia for authenticating the secure image.

With respect to claims 1, 5, 10, 12, and 15-17, Mehta teaches an underlayer penetrating (clm. 9) into a front surface of the media, the underlayer being printed using one of magenta and cyan ink (col. 2, lines 8-10), the underlayer being formed from a

series of small ink drops that are sufficiently small to prevent viewing with the naked eye and under normal light (col. 4, lines 32-39), where examination of a back surface (col. 2, lines 30-34) opposite the front surface allows viewing of the identification indicia for authenticating the secure image.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Daigneault to have the penetrating ink as taught by Mehta, in order to provide a hidden security feature which can be used to authenticate a document by exposure to ultraviolet light as taught by Mehta (col. 1, lines 63-65).

With respect to claim 3, Daigneault teaches an underlayer in the form of background watermarks that are formed into designs such as company logos. Watermarks are preprinted background images that are subsequently printed on top of by the end user. It would be obvious to subsequently print an image that completely covers the underlayer, in order to efficiently utilize printing media resources by printing on the entire sheet of paper.

5. Claims 4, 11, and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Daigneault in view of Mehta as applied to claims 1-3, 5, 10 and 12-17 above, and further in view of Silverbrook (US 6,431,704).

Daigneault in view of Mehta teaches the claimed invention except for the inkjet printing device for printing the underlayer being the same inkjet printing device for printing the overlayer and information from the input device being used for printing the overlayer.

Silverbrook teaches that inkjet printing devices can be used to print images that appear in the foreground of media (Fig.1), and information from an input device 24 being selected for printing the images.

It would have been obvious to one of ordinary skill in the art at the time of the invention to additionally modify Daigneault to have the inkjet printing device of Daigneault be used to print the overlaying images, in order to save time and money by only using one device to print the underlayer and the overlayer.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Applicant's attention is directed to US Patent 6,349,972, which describes watermarks as preprinted background images.

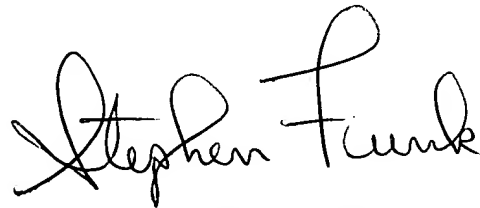
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kevin D. Williams whose telephone number is (703) 305-3036. The examiner can normally be reached on Monday - Friday, 8:30am - 6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew H. Hirshfeld can be reached on (703) 305-6619. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-7722 for regular communications and (703) 872-9319 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

KDW
August 6, 2003

A handwritten signature in black ink, reading "Stephen Funk". The signature is written in a cursive style with a large, looped "S" and "F".

**STEPHEN R. FUNK
PRIMARY EXAMINER**